

10/609,012 filed 06/27/2003
Theo T. Nikiforov
Reply to Office Action of January 10, 2006

REMARKS/ARGUMENTS

Claims 1-22 are pending in the above-captioned application, and all of these claims stand rejected. With this paper, claims 1 and 12 have been amended. No new matter was added with the amendment.

I. Information Disclosure Statement

Applicant thanks the Examiner for considering the information disclosure statements and acknowledges the duplicate references and references that were not considered.

II. Specification

As requested by the Examiner, Applicant has amended the specification to provide updated information concerning status of the priority applications.

III. Requirement for Information

Applicant is unable to respond to the Examiner's request to furnish the information redacted from "Molecular Devices Opposition to Motion for Preliminary Injunction" and declarations of Andrew R. Barron and J. Richard Sportsman. Applicant is not in possession of the missing information, has never been in possession of the information, and is not in a position to obtain the information. The aforementioned motion and declarations were filed by Molecular Devices Corporation (MDC) in the patent infringement action brought by Caliper Life Sciences (then named Caliper Technologies Corporation) against MDC. The information was redacted from these documents by MDC under a protective order that allowed their proprietary and/or trade secret information to be presented in the case for attorneys' eyes only.

Under 37 C.F.R. § 1.56, each individual associated with the filing and prosecution of a patent application has a duty to disclose to the Office "all information known to that individual to be material to patentability." Applicant and those who assisted Applicant with the present application have disclosed all information that is known to these individuals and that may be material. The information redacted from the infringement litigation documents was not then, and is not now, known to the Applicant, the undersigned attorney, or any other individual associated with the filing and prosecution of the present application.

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IV. Claim rejections under 35 U.S.C. § 102(b) as being anticipated by Mallia (US 5,527,688) as evidenced by Hawley's Condensed Chemical Dictionary and Whatman Product Guide

Claims 1–10 and 12–21 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Mallia (US 5,527,688) as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 236 and 237, 12th Edition, Van Nostrand Reinhold, New York, 1993) and Whatman Product Guide (pages 65 and 66, 1995). This rejection is respectfully traversed. “[F]or anticipation under 35 U.S.C. § 102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” MPEP § 706.02. “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to amended independent claims 1 and 12, at a minimum, Mallia does not teach a liquid reagent comprising a polymer or a molecule having multivalent metal cations associated therewith. The limitation “a liquid reagent comprising” has been added to claims 1 and 12 to more particularly point out and distinctly claim Applicant's invention. Support for the limitation can be found, for example, on page 34, lines 2–4 of paragraph 0119.

As noted by the Examiner on page 4 of the Office action, Mallia teaches multivalent metal cations (Fe^{3+}) bound to Whatman 3 MM paper. The paper is dry. *See* Mallia column 6, line 2. The paper is formed into membranes that are held in position in the bottoms of small buckets that are then placed into microcentrifuge tubes. *See* column 6, lines 9–14. A phosphorylated peptide is applied to the membranes, followed by a phosphopeptide binding buffer. The binding buffer is washed through the membranes by centrifugation, followed by a second wash step. *See* column 6, lines 40–62. The paper is not converted into a liquid reagent at any time, instead serving as a support.

Thus, Mallia does not teach every aspect of the claimed invention, either explicitly or impliedly, or show the identical invention claimed by Applicant in as complete detail as is contained in amended independent claims 1 and 12. Withdrawal of the rejection of claims 1 and 12 under § 102(b) as being anticipated by Mallia (US 5,527,688) as evidenced by *Hawley's Condensed Chemical Dictionary* and the Whatman Product Guide is, therefore, respectfully requested.

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Claims 2–10 depend directly from amended independent claim 1, while claims 13–21 depend directly or indirectly from amended independent claim 12. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claims 1 and 12. Withdrawal of the rejection of dependent claims 2–10 and 13–21 under § 102(b) as being anticipated by Mallia (US 5,527,688) as evidenced by *Hawley's Condensed Chemical Dictionary* and the Whatman Product Guide is, therefore, respectfully requested.

V. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Mallia (US 5,527,688), as evidenced by Hawley's Condensed Chemical Dictionary and Whatman Product Guide, and Strulovici (U.S. 5,759,787)

Claims 11 and 22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mallia (US 5,527,688), as evidenced by *Hawley's Condensed Chemical Dictionary* (pages 236 and 237, 12th Edition, Van Nostrand Reinhold, New York, 1993) and Whatman Product Guide (pages 65 and 66, 1995), and Strulovici (U.S. 5,759,787). The rejection of these claims is respectfully traversed.

To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142. As demonstrated above, the Mallia reference, as evidenced by *Hawley's Condensed Chemical Dictionary* and the Whatman Product Guide, neither teaches nor suggests all of the limitations of Applicant's amended independent claims 1 and 12. The Strulovici reference is silent with regard to a liquid reagent comprising a polymer or a molecule having multivalent metal cations associated therewith. Thus, amended independent claims 1 and 12 are nonobvious. Claim 11 depends directly from amended independent claim 1, and claim 22 depends directly from amended independent claim 12. Any claim depending from a nonobvious claim is also nonobvious. See MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 11 and 22 are nonobvious. Withdrawal of the rejections of these claims as being unpatentable over Mallia (US 5,527,688), as evidenced by *Hawley's Condensed Chemical Dictionary* and the Whatman Product Guide, and Strulovici (U.S. 5,759,787) is, therefore, respectfully requested.

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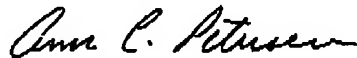
VI. Claim rejections on the ground of nonstatutory obviousness-type double patenting

Claims 1-6, 8, 10, and 12-19 were rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 26-31 of Nikiforov (US 6,689,565). A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) accompanies this Office action response. As indicated in the disclaimer, US 6,689,565 is commonly owned with this application.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed: 